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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,011	03/31/2000	Peter J. Kight	3350-31F	2558

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[REDACTED] EXAMINER

GARG, YOGESH C

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3625

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/540,011

Applicant(s)

KIGHT ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a)  The period for reply expires \_\_\_\_ months from the mailing date of the final rejection.  
b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_.

3.  Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4.  Newly proposed or amended claim(s) \_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_.

Claim(s) objected to: \_\_\_\_.

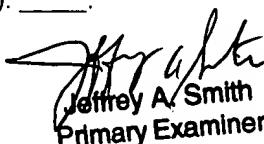
Claim(s) rejected: \_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) ( PTO-1449) Paper No(s). \_\_\_\_.

10.  Other: \_\_\_\_.

  
Jeffrey A. Smith  
Primary Examiner

Continuation of 3. Applicant's reply has overcome the following rejection(s): Rejection of claims 36,38,41,43-46, and 48-50 under 35 USC 112, first paragraph..

Continuation of 5. Other: With respect to the applicant's request for reconsideration, paper # 12, received on 4/10/2003 the applicant's arguments have been fully considered with regards to (i) request to identify the new grounds of rejection in the amended claims and to withdraw the finality of the rejection (ii) denied claim for priority under 35 USC 120 to July 25, 1991 (iii) rejection of claims 36, 38, 41, 43-46, and 48-50 under 35 USC 112, first paragraph and (iv) rejection of claims 36-50 under 35 USC 102 (e) as anticipated by Landry and the examiner's comments are as follows:

- A) Applicant's reply has overcome the rejection of claims 36, 38,41, 43-46, and 48-50 under 35 USC 112, first paragraph.
- B). The changes which necessitated new grounds of rejection in the amended claims, in paper # 9 are : (i) In claims 37, 39, 40, 42, 44, 45, 47, 49, and 50 the newly added limitation of " identifying " merchants or "identified " merchants" raises new issue which requires new consideration/search, and (ii) in claims 37, 38, the newly added limitation, " including information associated with merchants or identified merchants ", raises new issue which requires new consideration/search. Original claims did not include these limitations.
- C) Applicant's reply is not persuasive with regards to claim for priority under 35 USC 120 to July 25, 1991and, therefore, the denial to Cpriority claim to July 25, 1991, as analyzed and detailed in Final Action, paper # 11, is maintained. Notes: (i) With regards to the applicant's comments with respect to FIG.3 of the '072 patent and the unnumbered box labeled "rejects"(see pages 4, 5 of the response), this unnumbered box labeled " rejects" should be linked to the box "consumer pay table -38 " because the validation process is done against the pay table. (ii) With regards to the applicant's comments with respect to excluding disclosure found at column 4, lines 37-41 of the '113 Patent (see pages 5 and 6 of the response) the inclusion of an incorporation-by-reference statement of the '113 patent does not cure the exclusion of the disclosure scope in the later application for '072 patent because the exclusion of the disclosure scope in the later application makes the breath of scope indefinite as whether the software of the present invention is being used as per '113 patent or any other software is applicable as is apparent from the disclooure of the application for Patent '072.
- D) Since the denial to priority claim to July 25, 1991 is denied , rejection of claims 36-50 under 35 USC 102 (e) as anticipated by Landry is maintained. .